

Remarks

This paper is responsive to the Office Action mailed on January 17, 2006. At the time the Office Action was mailed, claims 1-28 were pending. By way of the present response Applicants have: 1) amended no claims; 2) added no claims; and 3) canceled no claims. As such, claims 1-28 remain pending. Applicants respectfully request reconsideration of the present application and allowance of all claims now presented.

Drawings

The Office Action Summary indicates that the Examiner objects to the drawings filed on 31 October 2000. As discussed in the previous response, Applicants submitted Formal Drawings to overcome the objections in the response mailed on April 22, 2005. The Office Action dated January 17, 2006 does not indicate reasons for further objections or entrance of the submitted Formal Drawings. Applicants respectfully request the Examiner accept and enter the Formal Drawings submitted in the response mailed April 22, 2005 and withdraw the objection. Applicants would be pleased to provide another copy of the previously submitted Formal Drawings at the Examiner's request.

Rejections Under 35 U.S.C. § 102

Claims 1-28 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Herz* et al. (U.S. Patent No. 5,835,087, herein referred to as "*Herz*"). Applicants submit that the rejections to claims 1-28 are improper.

Before considering the claim language, note that *Herz* relates to a completely different problem than the present invention. *Herz* relates to protecting a user from receiving unwanted

information, such as unwanted articles and junk mail (see, e.g. *Herz*, col. 2, lines 31-39, 48-51).

In contrast, the present invention relates to assisting a sender of a communication with addressing the communication in a more effective way.

A claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. Furthermore, the elements must be arranged in the prior art reference as required by the claim. (See MPEP 2131). The Office cannot ignore the relationships between words and phrases in a claim.

Herz does not disclose or suggest all of the limitations of any of Applicants' independent claims. In asserting that *Herz* discloses the limitations of the claimed invention, the Office has cited broad sections of *Herz*, making it difficult for Applicants to understand how the Office is interpreting *Herz*. Attempts to clarify the Examiner's interpretation during a telephone interview on April 24, 2006 were not successful.

Applicants see two interpretations of *Herz* which the Office could possibly be taking. Under both, at least one limitation of each of Applicants' independent claims is missing from *Herz*. The Office concludes that the present invention is anticipated by improperly adopting different and inconsistent interpretations of *Herz* within a single rejection of a single claim (e.g., claim 1).

For example, please consider the Office's rejection of claim 1. Claim 1 requires (alphabetical enumeration added):

1. *A method of addressing a communication for transmission over a network, the method including:
[a] accessing a descriptive profile of a potential recipient of the communication;*

[b] identifying the potential recipient as a suggested recipient of the communication based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient; and

[c] presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient, the suggested recipient being presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient.

Under no correct and consistent interpretation does *Herz* disclose or suggest both limitation [b] and limitation [c], as required by claim 1.

In rejecting limitation [b] of claim 1, the Office cites col. 5, lines 7-20, col. 18, lines 17-36, col. 5, lines 5-67 and col. 11, lines 5-51. In rejecting limitation [c] of claim 1, the Office cites col. 5, line 6 – col. 6, line 60, col. 74, lines 22-55, col. 75 – col. 76, line 51, and the Abstract.

Given the cited sections, the Office is either (1) improperly interpreting the “target object” of *Herz* as a “recipient” in one instance to assert that *Herz* discloses limitation [b] of claim 1 and then re-interpreting the “target object” as a “communication” to assert that *Herz* discloses limitation [c], or (2) improperly interpreting the “user” of *Herz* as a “recipient” in one instance to assert that *Herz* discloses limitation [b] of claim 1 and then re-interpreting the “user” as a “sender” to assert that *Herz* discloses limitation [c].

(1) Improper inconsistent interpretation of “target object”

Limitation [b] of claim 1 requires: “*identifying the potential recipient as a suggested recipient of the communication based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient.*”

The Office Action essentially treats limitation [b] of claim 1 as having two unrelated parts, [b1] and [b2], ignoring the relationships between words/phrases in the limitation. The Office Action cites col. 5, lines 7-20, and col. 18, lines 17-36 as disclosing [b1]: “identifying the potential recipient as a suggested recipient of the communication based on an evaluation.” (Office Action, p. 3). The Office Action cites col. 5, lines 5-67 and col. 11, lines 5-51 as disclosing [b2]: “of a correspondence between content of the communication and content of the descriptive profile of the potential recipient.” (Office Action, p. 3).

Col. 18, lines 17-36 of *Herz* describes an evaluation by a user who is presented with target objects of potential interest (e.g. articles of potential interest), which evaluation provides feedback to the system to determine how to filter target objects:

Relevance feedback only determines the user's interest in certain target objects: namely, the target objects that the user has actually had the opportunity to evaluate (whether actively or passively). For target objects that the user has not yet seen, the filtering system must estimate the user's interest. This estimation task is the heart of the filtering problem, and the reason that the similarity measurement is important. More concretely, the preferred embodiment of the filtering system is a news clipping service that periodically presents the user with news articles of potential interest. The user provides active and/or passive feedback to the system relating to these presented articles. However, the system does not have feedback information from the user for articles that have never been presented to the user, such as new articles that have just been added to the database, or old articles that the system chose not to present to the user. Similarly, in the dating service domain where target objects are prospective romantic partners, the system has only received feedback on old flames, not on prospective new loves. (*Herz*, col. 18, lines 17-36, emphasis added).

Accordingly, col. 18, lines 17-36 of *Herz* describes “an evaluation,” but the evaluation described in col. 18, lines 17-36 is of a target object (e.g. an article) by a user to provide feedback. The evaluation described in col. 18, lines 17-36 of *Herz* is not between a target object (or a profile of a target object) and any communication. As such, col. 18, lines 17-36 does not disclose or suggest “identifying the potential recipient as a suggested recipient of the

communication based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient,” as required by claim 1.

Col. 5, lines 7-20 of *Herz* describes an evaluation by the *Herz* system of potential target objects (e.g. articles) that may be sent to a user who receives articles. The evaluation is between profiles of target objects and a summary of information the user is interested in receiving (i.e. the user’s target profile interest summary):

The system for electronic identification of desirable objects of the present invention automatically constructs both a target profile for each target object in the electronic media based, for example, on the frequency with which each word appears in an article relative to its overall frequency of use in all articles, as well as a “target profile interest summary” for each user, which target profile interest summary describes the user’s interest level in various types of target objects. The system then evaluates the target profiles against the users’ target profile interest summaries to generate a user-customized rank ordered listing of target objects most likely to be of interest to each user so that the user can select from among these potentially relevant target objects, which were automatically selected by this system from the plethora of target objects available on the electronic media.” (*Herz*, col. 5, lines 7-20, emphasis added).

The Office is perhaps interpreting the target objects in col. 5, lines 7-20 of *Herz* to be potential target objects which are then identified as suggested target objects, in order to assert that *Herz* discloses “identifying the potential recipient as a suggested recipient of the communication based on an evaluation,” as required by limitation [b] of claim 1. If so, the Office must be interpreting the “target object” of *Herz* as the “recipient” of limitation [b] of claim 1. Since the “evaluation” described in col. 5, lines 7-20 of *Herz* is between a profile of the target object and a description of what the user is interested in receiving (i.e. the user’s target profile interest summary), to remain consistent, the Office must be interpreting the “user’s target

profile interest summary” as the “communication” of limitation [b] of claim 1. However, under the above interpretation of *Herz*, limitation [c] of claim 1 is missing from *Herz*.

Limitation [c] of claim 1 requires: *“presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient, the suggested recipient being presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient.”*

Under the above interpretation of *Herz*, the “user’s target profile interest summary” is considered to be the “communication” of claim 1. However, the user’s target profile interest summary is not disclosed in *Herz* as being transmitted to any recipient. Even if the Office construes *Herz* incorrectly to assert that the user sends the user’s target profile interest summary, at some time, to marketers based on col. 5, lines 52-67 of *Herz*, *Herz* still does not disclose or suggest “presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication,” as required by limitation [c].

The user of *Herz* is not presented with the suggested target object after the user has composed a draft of the user’s target profile interest summary (i.e. the alleged communication). In *Herz*, the user never composes a draft of the “user’s target profile interest summary.” As indicated by the Abstract of *Herz* and col. 5, lines 7-13, in *Herz*, the “user’s target profile interest summary” is automatically constructed by the system of *Herz*:

“This invention relates to....a system that automatically constructs both a "target profile" for each target object ..., as well as a "target profile interest summary" for each user.”
(*Herz*, Abstract, col. 5, lines 7-13).

Even if the Office construes *Herz* incorrectly to assert that the system of *Herz* is the sender of the user’s target profile interest summary (i.e., to the marketers), *Herz* does not disclose or suggest “presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication,” as required by limitation [c] of claim 1. The system of *Herz* is not presented with the suggested target object for selection as a confirmed target object after the system has composed a draft of the user’s target profile interest summary.

Accordingly, *Herz* does not disclose or suggest limitation [c] of “presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient, the suggested recipient being presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient.”

To assert that *Herz* discloses limitation [c], the Office appears to be improperly re-interpreting *Herz* in the same rejection by equating the “target object” as being the “communication” in limitation [c], after already equating the “target object” of *Herz* as being the “recipient” of limitation [b].

For example, the Office Action asserts that *Herz* discloses limitation [c] by stating that “*Herz* teaches presenting the presenting [sic] with a list of a target object after the user has composed a draft of a communication as shown in abstract of *Herz*.” (Office Action, Jan. 17,

2006, p. 12). The Office Action asserts: “*Herz* clearly shows a list of a target object after the user has composed a draft of a communication.” (Office Action, Jan. 17, 2006, p. 12).

The Abstract of *Herz* describes:

This invention relates to customized electronic identification of desirable objects, such as news articles, in an electronic media environment, and in particular to a system that automatically constructs both a "target profile" for each target object in the electronic media based, for example, on the frequency with which each word appears in an article relative to its overall frequency of use in all articles, as well as a "target profile interest summary" for each user, which target profile interest summary describes the user's interest level in various types of target objects. The system then evaluates the target profiles against the users' target profile interest summaries to generate a user-customized rank ordered listing of target objects most likely to be of interest to each user so that the user can select from among these potentially relevant target objects, which were automatically selected by this system from the plethora of target objects that are profiled on the electronic media... (*Herz*, Abstract, emphasis added).

As noted above, in *Herz*, both the “target profile” and the “user’s target profile interest summary” are automatically constructed by the system of *Herz*. Therefore, neither the “target profile” nor the “user’s target profile interest summary” can be the “draft of a communication” in the Office’s assertions, since “the user” does not compose a draft of either as required by claim 1. Accordingly, the Office Action appears to be interpreting the news articles of *Herz* as the “draft of a communication” that is composed before the list of target objects is presented to the user.

However, the news article described in the Abstract of *Herz* is a “target object,” (see e.g. col. 5, lines 9-12) which the Office has already interpreted as being the “recipient” of limitation [b]. The Office cannot interpret the target object of *Herz* to be, both, the “recipient” for limitation [b] of claim 1 and the “communication” for limitation [c] of claim 1. Moreover, it is nonsensical for the recipient of a communication to also be the communication itself.

The Office appears to be improperly adopting different and inconsistent interpretations of “target object” within the single rejection of claim 1 to assert that *Herz* discloses all the limitations of claim 1.

(2) Improper inconsistent interpretation of “user”

Applicants have also attempted to understand the Office’s rejections under a different interpretation. The Office cites col. 11, lines 5-51 of *Herz* as disclosing “a correspondence between content of the communication and the content of the descriptive profile of the potential recipient,” as required by limitation [b] of claim 1. In col. 11, lines 5-51, *Herz* includes the statement: “consider a domain where the user is an advertiser and the target objects are potential customers.”

Perhaps the Office is interpreting the customers in col. 11, lines 5-51 of *Herz* to be the potential target objects which are then identified as suggested target objects in order to assert that *Herz* discloses “identifying the potential recipient as a suggested recipient of the communication based on an evaluation,” as required by limitation [b] of claim 1. Under such an interpretation, the Office is still interpreting the “target object” as the “recipient” of limitation [b] of claim 1, as discussed in the section above.

Accordingly, the same problem arises as discussed above: limitation [c] of claim 1 is still missing from *Herz*. The advertiser’s target profile interest summary is never described as being transmitted to any recipient. The advertiser of *Herz* is not presented with the suggested customer (the alleged recipient) after the advertiser has composed a draft of the user’s target profile interest summary (the alleged communication). The advertiser of *Herz* never composes a draft of the advertiser’s target profile interest summary.

To assert that *Herz* discloses limitation [c], perhaps, in this instance, the Office is interpreting the user of *Herz* (here, the advertiser) also as the entity (which is not described in *Herz*) who must be composing the newspaper article described in the Abstract of *Herz*. However, this interpretation is also improper and inconsistent.

First, in *Herz*, as discussed above, the newspaper article is a target object. *Herz* never discloses or suggest that a user in *Herz* who receives target objects (e.g. the advertiser who receives a list of potential customers) is, at the same time, the entity that sends other target objects. The Office cannot interpret the user of *Herz* to be, both, a recipient of a target object and the sender of a target object in *Herz*.

Second, even incorrectly assuming, *arguendo*, that a user in *Herz* both sends and receives target objects in order to assert that *Herz* discloses limitation [c], *Herz* in that event would no longer disclose limitation [b].

Limitation [b] requires “an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient.” If one target object (the newspaper article) is interpreted as the “communication” of claim 1 (rather than the advertiser’s target profile interest summary as discussed above) and another target object (the customer) is interpreted as the “potential recipient” of claim 1, then to disclose limitation [b], *Herz* would have to disclose an evaluation between the newspaper article target object and the customer target object.

However, *Herz* never discloses or suggests an evaluation between the newspaper article target object and the profile of the customer target object. *Herz* describes evaluations between target objects, but the evaluations between target objects are between target objects of the same

kind (e.g. article-to-article or customer-to-customer) to determine whether one target object should be sent the user (the advertiser) based feedback on another target object:

In all these cases, the information delivery process in the preferred embodiment is based on determining the similarity between a profile for the target object and the profiles of target objects for which the user (or a similar user) has provided positive feedback in the past. (*Herz*, col. 6, lines 13-18, emphasis added).

Herz does not disclose or suggest an evaluation between target objects of different kinds (e.g. article-to-customer), or even any motivation to do so. Accordingly, even assuming, incorrectly and inconsistently, that *Herz* discloses a user who both sends and receives target objects to assert that *Herz* disclose limitation [c] of claim 1, *Herz* does not disclose or suggest limitation [b] of “a correspondence between content of the communication and content of the descriptive profile of the potential recipient. “

Under no correct and consistent interpretation does *Herz* disclose or suggest both limitation [b]: “*identifying the potential recipient as a suggested recipient of the communication based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient*” and limitation [c]: “*presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient, the suggested recipient being presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient,*” as required by claim 1.

Applicants provide the following table in an attempt to help summarize the pertinent parts of *Herz*:

Domain	“user” in <i>Herz</i>	“target object” in <i>Herz</i>	<i>Herz</i> evaluates	<i>Who receives what</i>	<i>Result</i>
advertiser interested in customers	advertiser	customer	advertiser’s target profile interest summary and profile of customer	advertiser receives customized rank ordered listing of customers	No disclosure of any relationship between any communication the advertiser may send and what is evaluated
users interested in articles	user who receives news articles	news article	user’s target profile interest summary and profile of news article	user receives customized rank ordered listing of news articles	No disclosure of any relationship between any communication the user may send and what is evaluated

Herz’s failure to disclose all the limitations of claim 1 is consistent with the fact that *Herz* is directed at a completely different problem than the present invention. *Herz* is directed towards protecting a user from receiving unwanted information, such as unwanted articles and junk mail (see, e.g. *Herz*, col. 2, lines 31-39, 48-51). In contrast, the present invention is directed towards assisting a sender of a communication with addressing the communication in a more effective way.

Only by improperly adopting different and inconsistent interpretations of *Herz* within a single rejection (e.g., the rejection of claim 1) can one reach the conclusion that *Herz* discloses all the limitations of claim 1. On the other hand, under a correct and consistent interpretation of *Herz*, at least one limitation of claim 1 is missing from *Herz*. Accordingly, Applicants respectfully submit that claim 1 is patentable over *Herz*.

Similar arguments are applicable to independent claims 14, 27 and 28. Accordingly, Applicants respectfully submit that independent claims 14, 27 and 28 are also patentable over *Herz*. The remaining claims dependent directly or indirectly from one of the foregoing independent claims. Therefore, Applicants respectfully submit the remaining claims are also patentable over *Herz*.

Conclusion

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Jordan Becker at (408) 720-8300.

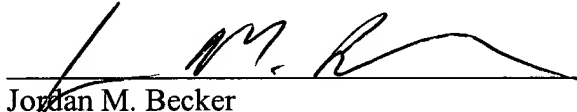
Pursuant to 37 C.F.R. 1.136(a)(3), Applicants hereby request and authorize the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 C.F.R. 1.16 and 1.17, to Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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